

### **Remarks**

Claims 1-3 and 5-16 are pending. Claims 1-4 and 7-15 are presently rejected under §102 (b) as anticipated by U.S. Patent No. 6,497,361 to Mason (hereinafter "Mason".) Claims 5-6 and 16 are presently rejected under 35 USC §103 as obvious over Mason. Claims 1-16 are rejected under 35 USC §112 for being indefinite.

In response, Applicant have amended claim 1 to include the limitations of claim 4 and to overcome the §112 rejection. Claim 4 has accordingly been cancelled. Claim 16 has similarly been amended to include claim limitations of claim 4 and to overcome the §112 rejection. Claims 2, 3, 6, 9-11, 14 and 15 have been amended to clarify different types of claimed prompts and to improve antecedent basis.

Further, the Examiner stated "This application contains claims 17-28 drawn to an invention nonelected with traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP §821.01." In response, as claim 17-28 were not examined on the merits, Applicant herein cancels claims 17-28 without prejudice. Applicant is unsure why the withdrawn claims could not be kept until allowance as is normal.

### **Claim Rejections- 35 USC § 102**

10. Claims 1-4 and 7-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Mason (US 6,497,361). Mason discloses a customer self-checkout system for processing article purchases of articles normally having a security tag attached thereto, the system comprising: a self-checkout station comprising: an input device configured to receive product code input designating an article for purchase; a deactivation device configured to produce a deactivation region affecting deactivation of a security tag attached to an article for purchase; and a prompting system configured to present a deactivation prompt to direct a user to position an article for purchase within the deactivation region to effect security tag deactivation.

The Examiner's rejection is respectfully traversed. As an initial matter, the Examiner has failed to point out with specificity, in this office action or the previous office action of September 14, 2005, what parts of Mason's disclosure contains art that the Examiner believes anticipates every element of Applicant's claims. The Examiner's obligation in citing prior art is greater than generally alluding to a reference as anticipating all elements of Applicant's claims without any comment or explanation. Instead, it is the Examiner's responsibility to point out the parts of the cited reference that were relied upon (i.e., columns and lines). See *Ex Parte Akira Ishii*, 1998 WL 1758178 (Bd. Pat. App & Interf.). The Examiner has not met this burden. Instead, the Examiner simply stated "Mason discloses [Applicant's claim language]" without any further reasoning or explanation.

Additionally, it is well established that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). It is not enough that the cited reference discloses all the claimed elements in isolation, but the reference must disclose each element of the claimed invention "arranged as required by the claim." (MPEP § 2131).

Contrary to the Examiner's assertions, the Mason reference clearly fails to disclose the prompting system element claimed in the present application, namely **"a prompting system configured to present a deactivation prompt to direct a user to position an article for purchase within the deactivation region to effect security tag deactivation, wherein the prompting system is configured to present the deactivation prompt after a receipt of a product code by the input device,"** as claimed, *inter alia*, in Applicant's claim 1.

The lack of a prompting system in Mason was previously argued in Applicant prior response to the non-final office action. Specifically, in the response of March 20, 2006, Applicant stated:

Contrary to the Examiner's assertion, the Mason reference does not describe a prompting system, and in fact mentions the word "prompt" or its derivatives only twice, in connection with prompting a customer to initiate self-checkout by sweeping his or her credit card (in column 2, line 60), or prompting a customer to move a scanned article, from the scanning and deactivation area after deactivation of the tag, to the "itemized area" (i.e., packaging area) (in column 4, line 19). These are courtesy prompts that are unrelated to the claimed interactive prompts of applicant's claims. Anti-theft tag deactivation in the Mason reference is automated and done with no prompting and manual intervention by a customer. In fact, Mason specifically contemplates a combined automated scanning and deactivation process by attachment of the anti-theft tag in a certain

location on the article for purchase relative to an article's bar code or other identifying mark. (See, Mason Column 3, lines 16-30 and Figures 3, 4).

In response to this argument in the present office action, the Examiner was dismissive and stated that:

**Regarding the argument that the references applied in the rejection fail to use the same names for certain elements as the names used by Applicant, that argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but need not be in identical words as used in the claims in order to be anticipatory.**

In other words, the Examiner read Applicant's argument to be simply based on the premise that Mason barely used the word 'prompt.' If the Examiner re-reads Applicant's prior arguments, he will see that this was a misrepresentation of Applicant's position. Applicant was not basing the argument on Mason's infrequent use of the word 'prompt', but on the fact that Mason does not describe a prompting system that prompts a user to de-activate the an anti-theft tag. The frequency of the word 'prompt' was merely one point out of several to support this argument. The Examiner, however, did not respond to the argument as is the Examiner's responsibility. See Ex Parte Sherman, Appeal 2006-2994, 2007 WL 43131 (Bd. Pat. App. & Interf.).

Thus, Applicant re-argues that Mason does not disclose a prompting system as claimed by Applicant. Mason instead discloses a system having (1) an *itemization* area and (2) an *itemized* area. Note that the names of the two areas are very similar, but they are not the same location. Items are placed in the itemization area wherein the items are (a) bar code scanned or otherwise identified, and (b) deactivated. The items are then moved from the itemization area to the itemized area for bagging. See Mason, column 2, lines 37-44. The itemization area is framed within some kind of structure, for example a hood enclosure or, alternatively, rails. See Mason, column 2, lines 22-27. The itemization area is defined in such a way that it facilitates the correct placement of the article to be checked out in the itemization area by the purchaser. See Mason, column 2, lines 28-30. In other words, it is the structure of the itemization area in Mason that facilitates placement of items, not a prompt. No prompt indicated placement is used. Thus Mason does not disclose a 'deactivation prompt' as claimed, *inter alia*, in Applicant's claim 1.

In embodiments of Mason where the articles have bar codes, once an item is properly placed into the itemization area, the EAS tag is immediately proximate to the deactivator, and the identifying mark [bar code] is immediately proximate to the item detector. The item is then scanned and **deactivated at the same location, i.e., the itemization area.** See Mason, column 3, lines 16-52. If the item has no bar

code, the user enters item codes when the products are within the itemization area, after which the items are deactivated in the itemization area. See Mason, column 3, lines 56 – 66. **In either case, there is no movement from scanning/identifying to deactivation and no prompting is done between these steps.** Thus Mason does not disclose a prompting system ‘configured to present the deactivation prompt after a receipt of a product code by the input device,’ as claimed, *inter alia*, in Applicant’s claim 1. Indeed, no movement or user intervention is required between these steps, and thus a prompt would be unnecessary. It would be counterintuitive to prompt the user when no user intervention is required.

If the item is deactivated, the item is moved from the itemization area to the itemized area. Mason, column 3, lines 44-46. The item can be moved by a conveyor belt or by the user after a prompt. Mason, column 4, lines 8-20. This prompt, however, only happens *after* the deactivation. Thus, Mason does **not** disclose customer self-checkout system for processing article purchases as claimed by Applicant in claim 1, *inter alia*, a prompting system configured to present a **deactivation prompt** to direct a user to position an article for purchase within the deactivation region to effect security tag deactivation, **wherein the prompting system is configured to present the deactivation prompt after a receipt of a product code by the input device.**

As every limitation is required to be anticipated by §102, Applicant believe the rejection of claim 1 based on Mason is overcome in light of the above arguments.

Claims 2-3 and 7-15 depend, directly or indirectly, on claim 1 and are patentable over Mason for at least the reasons stated with respect to claim 1. These claims are also allowable for at least the reasons stated below. Many of these arguments were made in Applicant’s prior response. The Examiner, however, did not substantively respond or comment on most of them. Additionally, Applicant had respectfully asked the Examiner to identify where in Mason lay disclosure that the Examiner believed anticipated Applicant’s claims. The Examiner, again, did not do this. Thus, Applicant respectfully requests the Examiner performs his obligations when considering these arguments.

Claim 3 of the present application teaches a target visibly disposed proximate the deactivation region at the checkout station, wherein the second prompt instructs the user to move the article to touch the target to effect security tag deactivation. Contrary to the Examiner’s assertion, the system in Mason does not include a target visibly disposed proximate to the deactivation region, and it also does not include a second or any prompt to instruct or facilitate tag deactivation. Instead, the deactivation area in Mason is not separated or distinguishable from the scanning area, with both scanning and deactivation occurring automatically and without any prompts in the same area. The Examiner is respectfully

requested to identify where in the Mason Reference a teaching of the present application's claim 3's prompting system is found.

Claim 7 of the present application teaches a sensor for sensing the presence of an article within the deactivation area. Further contrary to the Examiner's assertion, Mason does not teach a sensor that is dedicated to sensing the presence of an article within the deactivation area, since Mason does not teach a dedicated deactivation area where a special sensor may be located to perform certain functionalities specifically related to tag deactivation. The Examiner is respectfully requested to identify where in the Mason Reference a teaching of the present application's claim 7's prompting system is found.

Claim 8 of the present application teaches a scale operatively coupled to the prompting system, wherein the scale communicates with the prompting system to provide a deactivation prompt when a weight change is detected by the scale and the sensor of the deactivation area has not sensed the presence of the weighed article within the deactivation area. Further contrary to the Examiner's assertion, Mason does not teach a prompting system coupled to a scale for assisting error-free deactivation. In contrast, Mason's scale is used only to provide an additional parameter to determine the identity of scanned articles for purchase. The Examiner is respectfully requested to identify where in the Mason Reference a teaching of the present application's claim 8's prompting system is found.

Claim 9 of the present application teaches a prompting system configured to present a prompt providing instructions to a user to place an article for purchase into a bag on the bagging platform. Further Contrary to the Examiner's assertion, Mason does not teach any such prompting system or specific prompt. The Examiner is respectfully requested to identify where in the Mason Reference a teaching of the present application's claim 9's prompting system is found.

Claim 10 of the present application teaches a bagging platform having a bag holder adapted to hold a bag for receiving articles. Contrary to the Examiner's assertion, Mason does not teach any such bag holder for receiving articles. The Examiner is respectfully requested to identify where in the Mason Reference a teaching of the present application's claim 10's prompting system and bagging platform are found.

Claim 11 of the present application teaches a prompting system configured to present a feedback prompt to confirm deactivation of the security tag after the sensor of the deactivation area senses presence of an article within the deactivation area. Contrary to the Examiner's assertion, Mason does not disclose any such prompting system, a feedback prompt, or a dedicated sensor for sensing the presence of an

article within the deactivation area. The Examiner is respectfully requested to identify where in the Mason Reference a teaching of the present application's claim 11's prompting system is found.

Claim 12 of the present application teaches a feedback prompt that further prompts a user to put an article for purchase in a bag. Contrary to the Examiner's assertion, Mason does not teach any feedback prompt that instructs a user to put an article for purchase in a bag. The Examiner is respectfully requested to identify where in the Mason Reference a teaching of the present application's claim 12's prompting system is found.

Claim 14 of the present application teaches an animated prompt. Contrary to the Examiner's assertion, Mason does not teach an animated prompt of any sort, let alone one for deactivation. The Examiner is respectfully requested to identify where in the Mason Reference a teaching of the present application's claim 14's animated prompt.

Claim 15 of the present application teaches a prompting system where the deactivation prompt is by an audio device. Contrary to the Examiner's assertion, Mason does not a prompting system where the deactivation prompt is by an audio device. The Examiner is respectfully requested to identify where in the Mason Reference a teaching of the present application's claim 15's audio prompt for deactivation.

For at least the reason that Mason fails to disclose or suggest one or more elements of claims 1-3 and 7-15, the Examiner's rejection of these claims for anticipation under 35 U.S.C. §102 in light of Mason is improper and should be withdrawn. Accordingly, it is respectfully requested that the Examiner withdraw his rejection and allow claims 1-3 and 7-15.

### **Claim Rejections- 35 U.S.C. § 103**

12. Claims 5, 6, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over mason (US 6,497,361).

Mason discloses a customer self-checkout system for processing article purchases, as applied above in the rejection of claims 1 and 4 under 35 U.S.C. 102(b), but Mason fails to disclose that the database system coupled to the self-checkout station and comprising stored data identifying articles having attached security tags also stores data on articles not having attached security tags to determine whether an article designated by the received product code input has an attached security tag; and

wherein the prompting system is configured to present the deactivation prompt when the article has an attached security tag and to not present the deactivation prompt when the article does not have an attached security tag, the system of Mason presenting the deactivation prompt when the stored data associated with an article does not indicate whether said article has an attached security tag or not, since the system of Mason seems to assume that all items in the store would have a security tag needing to be deactivated.

However, it is well known to those of ordinary skill in the art, that, ordinarily, due to the cost of the security tag, not all items in a store are provided with a security tag, and it would be self-evident/inherent that items not having security tags would not need to have a security tag deactivated.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Mason so as to use store in the database of item weights, an indication as to whether or not each item is protected by a security tag, and to only deactivate tags for items that have such tags, as is well known to do, in order to accommodate stores having a mix of inventory partially protected by security tags and partially not protected by security tags, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected result.

The Examiner's rejection of claims 5, 6, and 16 under 35 U.S.C. § 103 as unpatentable over Mason is respectfully traversed.

It is well established that, to establish a *prima facie* case of obviousness, among other things, the combination of references must have all of the claimed limitations.

As explained above, Mason does not show a prompting system configured to present a deactivation prompt to direct a user to position an article for purchase within the deactivation region to effect security tag deactivation, wherein the prompting system is configured to present the deactivation prompt after a receipt of a product code by the input device.

In contrast, claims 5, 6 and the amended claim 16 of the present invention teach a self-checkout system which includes, among other elements, the prompting system described *supra*. Moreover, while the Examiner asserts that it would be inherent/self-evident that articles not having security tag would "not need deactivation," the Examiner made no assertion that articles not having a security tag would not need

a deactivation *prompt*. Claim 5 recites a “prompting system [] configured to present the deactivation **prompt** when the article has an attached security tag and to not present the deactivation **prompt** when the article does not have an attached security tag.” Claim 16 has a like clause and claim 6 depends from claim 5. Thus, the issue is not whether deactivation is required, but whether a *prompt* to deactivate is required. Since Mason does not teach a deactivation prompt at all, one skilled in the art would not read Mason to obviously show a step of deciding whether to use a deactivation prompt since such a step would be completely unnecessary if a deactivation prompt was not used in the first place. Because Mason simply fails to disclose or suggest all the elements of the claims (as required by the MPEP § 2142), the rejection under 35 U.S.C. § 103(a) is not supported and is improper. Claims 5, 6 and 16 are therefore believed allowable.

### **Claim Rejections- 35 U.S.C. § 112**

**1            Claim[s] 1-16 are rejected under 35 U.S.C., second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**The term “normally” in claims 1 and 16 (line 2 of each claim) is a relative term which renders the claim indefinite.**

In response to this rejection, Applicant have removed the term ‘normally’ from claim 1 and 16. The §112 rejection is therefore believed overcome and claims 1 and 16 are correspondingly allowable. As claims 2-3 and 5-15 depend from claim 1, either directly or through intervening claims, these claims are likewise believed allowable.

### **Conclusion**

For the foregoing reasons, allowance of this application, as amended, is courteously urged. Amended claims 1-3 and 5-16 are now pending and believed to be in condition for allowance.

If there remain any questions regarding the present application, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to



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contact the undersigned at (212) 878-8429 in order for the undersigned to arrange for an interview with the Examiner.

Please charge any additional fees for this Amendment or credit any overpayments to Deposit Account No. 50-0521.

Respectfully submitted,



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Eric A. Lerner  
Reg. No. 46,054

Customer No. 27383  
Clifford Chance US LLP  
31 West 52<sup>nd</sup> Street  
New York, NY 10019-6131  
Telephone: (212) 878-8232